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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,948	12/14/2000	Satoshi Kawahata	FUJI 18.089	1527
26304	7590	06/29/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			SCHEIBEL, ROBERT C	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
			2666	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,948

Applicant(s)

KAWAHATA ET AL.

Examiner

Robert C. Scheibel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8 and 11-15 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 20050623
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see page 15, filed 10/7/2004, with respect to objections to the specification have been fully considered and are persuasive. The objections to the specification have been withdrawn.
2. Applicant's arguments, see page 15, filed 10/7/2004, with respect to objections to the drawings have been fully considered and are persuasive. The objections to the drawings have been withdrawn.
3. Applicant's arguments with respect to claims 1-3, 6-8, and 11-15 have been considered but are moot in view of the new grounds of rejection made in view of newly found reference U.S. Patent 6,067,457 to Erickson et al.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-2, 4, 9, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 1-2, 4, 9, and 11 recite the limitation "the second terminal" in lines 11 (claim 1), 7 (claim 2), 4-5 (claim 4), 2 and 6-7 (claim 9), and 4 (claim 11). There is insufficient antecedent basis for this limitation in the claim. It appears that line 7 of the original claim 1 was accidentally deleted in this amendment and should be added back to overcome this rejection.

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4. Claim 9 recites the limitation "the read out service type" in lines 11 and 12 (three instances). It is unclear whether this refers back to the read out service type of lines 14 and 15 of claim 1 or the read out service type of line 8 of claim 9. Appropriate correction is required.

5. Claim 10 recites the limitation "the read out service type" in lines 7 and 8 (three instances). It is unclear whether this refers back to the read out service type of lines 14 and 15 of claim 1, the read out service type of line 8 of claim 9, or the read out service type of line 4 of claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of U.S. Patent 6,067,457 to Erickson et al.

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Regarding claims **1 and 12-15**, the general structure of the preamble of each of these claims is disclosed in Figure 20. The functionality of both the exchange and the connecting device are contained in the IP Network Connection Device 2 of Figure 20. There is nothing in the claim language that distinguishes the exchange from the similar functionality of the connecting device 2 of figure 20. As described in lines 12-21 of page 2, the limitation of claims 1 and 15 of the exchange holding priority classes and the limitation of the connecting device holding service types is disclosed as the connecting device 2 must have priority classes associated with the terminals to determine what priority to use when sending the packets and it must have a service type in order to determine what value to insert into the IP TOS field when transmitting the packet on the IP network so as to indicate the packet's priority to other network devices. Further, the step of the first exchange (subsystem within device 2) notifying the connecting device (another subsystem within device 2) of the priority class of a terminal when a call is set up, clearly must exist in order to allow the connection device subsystem to modify the packets according to this priority. Similarly, the limitation of the first connection device reading out a service type corresponding to the priority class also exists in order for the connection device subsystem to be able to insert the proper value in the TOS field of the packets. The limitation of claims 1 and 15 of the connecting device setting the saved service type is disclosed in Figure 20 in the field of the packet P1. The limitation of claims 1 and 15 of the first exchange specifying a call-in terminal when a call is set between a call-out terminal and call-in terminal is disclosed inherently. Figure 20 discloses one embodiment that reads on this and indicates that calls are made between a call-out terminal and a call-in terminal; the exchange must inherently specify a call-in terminal in order for a connection to be set up. Similarly, regarding claims 12

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and 13, the priority class storage section, the acquiring section, and the priority class notifying section are disclosed in the exchange subsystem of element 2 as detailed in the related steps of claims 1 and 15 above. Regarding claims 12 and 14, the service type storage section, the reading section, the saving section, and the setting section are all disclosed in Figure 20 as detailed in the related steps of claims 1 and 15 above.

AAPA does not disclose expressly the limitation that the exchange and the connecting device are separate devices. AAPA also does not disclose expressly the limitation when the call-in terminal is a predetermined terminal, the first exchange notifies the first connecting device of a priority class which is equal to or higher than the priority class corresponding to the call-out terminal. However, it would have been obvious to one of ordinary skill in the art to modify the connecting device of Figure 20 such that the same functionality is performed in two separate devices (and exchange and a connecting device). The motivation for doing so would have been to achieve reduced network cost by decentralizing the functionality of connecting device 2 of Figure 20. The exchange would be less complex than the combined device 2 and could be deployed at customer premises, for example. In addition, a single connecting device could support multiple exchanges. The combination of the less expensive exchange and the single connecting device supporting multiple exchanges clearly would result in a cost savings.

However, AAPA, modified as above, does not disclose expressly the limitation when the call-in terminal is a predetermined terminal, the first exchange notifies the first connecting device of a priority class which is equal to or higher than the priority class corresponding to the call-out terminal. However, this is well known in the art. As an example, consider U.S. Patent 6,067,457 to Erickson et al. Erickson discloses the concept of giving priority to certain calls

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(such as emergency calls) throughout (see the abstract for example). Clearly, an emergency call discloses the limitation of a call-in terminal being a predetermined terminal (911 for example), and Erickson discloses giving this type of call a higher priority. AAPA and Erickson are analogous art because they are from the same field of endeavor of digital voice communication. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify AAPA to give higher priority to calls to certain pre-determined terminals (such as emergency calls); this would clearly involve the exchange notifying the connecting device of the AAPA of the higher priority. The motivation for doing so would have been to provide the communication resources to calls that can gain the most benefit from the use of these resources as suggested by Erickson in lines 52-56 of column 2. Therefore, it would have been obvious to modify the AAPA by decentralizing the functionality of the connecting device for the benefit of lower costs and to combine Erickson with AAPA for the benefit of providing resources to the calls that can gain the most benefit to obtain the invention as specified in claims 1 and 12-15.

Regarding claim 11, the limitation that the exchange holds priority classes corresponding to an attribute of each terminal, the limitation that the exchange detects an attribute of the terminal when a call is set, and the exchange notifies the connecting device of the priority class corresponding to this attribute is also disclosed by the AAPA. It is clear that in order to distinguish among priority levels for the terminals C and D of Figure 20, the exchange subsystem of the device 2 must use some attribute to determine the corresponding priority level.

9. Claims 2-4, 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of U.S. Patent 6,735,175 to Havens.

AAPA discloses all the limitations of parent claim 1 as explained above. AAPA also discloses the limitation of the connecting device editing the packets in Figure 20 (adding the corresponding service type to the packets before sending them on the IP network.) However, AAPA does not disclose expressly the limitations of claims 2-3 or 6-8.

Regarding claim 2, Havens discloses the limitation of the first connecting device notifying the second connecting device of the service type in lines 12-14 of column 2 as well as in Figure 1. Figure 1 indicates how the call is set up with the first connecting device (the combination of the MG 207 and MGC 205) notifying the second connecting device (209 and 211) of the parameters for use in the call. The service type in this case is the codec and rate of sampling. In order to perform two-way communications in the call, the steps of the second connecting device saving the service type and setting the service type in the packets from the call-in to call-out devices (via the codec algorithm used) are required.

AAPA and Havens are analogous art because they are in the same field of endeavor of voice over IP communications systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify AAPA to exchange end-to-end call setup information at the start of the call. The motivation for doing so would have been to allow provide consistent quality of service for traffic in both directions in the same call. Therefore, it would have been obvious to combine Havens with AAPA for the benefit of consistent quality of service in both directions of a call to obtain the invention as specified in claim 2.

Regarding claims 3-4, Havens discloses the limitation of the exchange receiving an indication of the change in the priority level in the change in QoS described in lines 12-16 of column 4. Havens discloses the limitation of the connecting device storing the new service type

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corresponding to the priority and setting the new service type to the packets. In the case of Havens, the QoS is the priority class and the codec algorithm is the service type. Regarding claim 4, Havens discloses the limitation that the first connecting device notifies the second connecting device of the read out new service type and the second connecting device saves the new service type from the first connecting device and sets the new service type to packets when transmitting packets with data from the second terminal as the call-in terminal in lines 34-38 of column 4. Since it is clear that the voice call is bi-directional, it is clear that this change in the codec algorithm in MG 211 will change the QoS level for packets transmitted back to the call-out terminal as well as those received from the call-out terminal.

Regarding claim 6, Havens discloses the limitation of the first connecting device determining a method for compressing and encoding data in lines 12-17 of column 2. Havens also discloses the first connecting device compressing and encoding according to the determined method in lines 37-44 of column 3.

Regarding claim 7, Havens discloses the limitation of the connecting device detecting a service type or priority class corresponding to the communication and changing the method for compressing and encoding in the caller entering keystrokes to change the QoS in lines 12-38 of column 4.

Regarding claim 8, Havens discloses the limitation of the first connecting device compressing and encoding the data in lines 37-44 of column 3. Havens also discloses the limitation of detecting a service type or priority class and changing the number of the compressed and encoded voice data in lines 12-38 of column 4. The new QoS level is the number of the compressed and encoded data.

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AAPA and Havens are analogous art because they are in the same field of endeavor of voice over IP communications systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify AAPA to allow the encoding scheme to be determined at call setup and to be changed according to the user during the call. The motivation for doing so would have been to allow the caller to change the QoS during a call as specified in lines 18-24 of column 2 of Havens. Therefore, it would have been obvious to combine Havens with AAPA for the benefit of allowing users to change QoS to obtain the invention as specified in claims 3-4 and 6-7.

Allowable Subject Matter

10. Claims 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Paten 6,028,915 to McNevin discloses a method and apparatus for making an emergency call while on-line on a computer and U.S. Patent 5,864,755 to King et al discloses a method for allowing a mobile phone to receive a call through a wireless network for which it is not registered, for emergency purposes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169. The examiner can normally be reached on Monday and Thursday from 6:30-5:00 Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RC5 6-27-05
Robert C. Scheibel
Examiner
Art Unit 2666

Seema S. Rao
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